

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:

Elliot A. Gottfurcht

Serial No.: **10/646,066**

Filed: August 21, 2003

For: **Method to Generate Advertising
Revenue Based on Time and Location**

Examiner: Donald Champagne

Art Group: 3622

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant (hereinafter "Appellant") submit the following Appeal Brief, pursuant to 37 C.F.R. § 41.37 for consideration by the Board of Patent Appeals and Interferences. Appellant also submits herewith a check in the amount of \$250.00 to cover the cost of filing the opening brief as required by 37 C.F.R. § 41.37(a)(2). Please charge any additional amount due or credit any overpayment to deposit Account No. 02-2666.

TABLE OF CONTENTS

	Page
I. REAL PARTY IN INTEREST	3
II. RELATED APPEALS AND INTERFERENCES.....	3
III. STATUS OF CLAIMS.....	3
IV. STATUS OF AMENDMENTS	3
V. SUMMARY OF CLAIMED SUBJECT MATTER	3
VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.....	6
VII. ARGUMENT	6
A. Overview of the Prior Art.....	6
1. Overview of <u>Herz</u>	6
1. Overview of <u>Szabo</u>	7
B. Rejection of Claims 108-205 Under 35 U.S.C. § 103 over Herz in view of Szabo	8
C. Objection to Claims 111, 135, 159 and 183 as in Improper Dependent Form Based on 37	
C.F.R. § 1.75(c).....	38
VIII. CLAIMS APPENDIX	42
IX. EVIDENCE APPENDIX.....	61
X. RELATED PROCEEDINGS APPENDIX.....	62

I. REAL PARTY IN INTEREST

Elliot A. Gottfurcht, the party named in the caption, is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this Appeal.

III. STATUS OF CLAIMS

Claims are pending in the application. The Examiner has rejected claims 108-205. The Appellant hereby appeal the rejections of claims 108-205.

IV. STATUS OF AMENDMENTS

No claim amendments were submitted after the Final Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The pending claims relate to a method and apparatus to efficiently navigate content on a wide area network such as the internet. (See Abstract.) Specifically, the method and apparatus relate to the display of advertisements within a simplified navigation system. (See Specification, paragraph [0085] and Abstract.) Independent claims 108, 132, 156 and 181 and dependent claims 109-131, 133-155, 157-180 and 182-205 are presented in this appeal. The location of descriptions corresponding to the elements of the claims are identified by paragraph numbers, as well as drawings references, from the originally filed Application as required by 37 C.F.R. § 41.37(c)(1)(v).

Independent claims 108 and 132 recite: “receiving a plurality of bids to display advertising in association with a keyword (paragraph [0086]); ranking the plurality of bids based on at least one criterion (paragraph [0086]); displaying an advertisement associated with a highest ranked bid of the plurality of bids with the keyword in a navigation interface (paragraph [0085]), the navigation interface having a plurality of increasingly specific hierarchical layers (paragraphs [0053]-[0056]); and displaying content via an internet that is associated with the advertisement, any one of the content or the advertisement formatted for navigation with unique inputs (paragraph [0069]).”

Independent claims 156 and 181 recite “receiving a plurality of bids to display advertising in association with a keyword (paragraph [0086]); ranking the plurality of bids based on at least one criterion (paragraph [0085]); and displaying an advertisement associated with a highest ranked bid of the plurality of bids with the keyword in a navigation interface, the navigation interface having a plurality of increasingly specific hierarchical layers (paragraphs [0057] and [0074]).

Dependent claims 109, 133, 157 and 182 recite “providing an account management interface to a user through the navigation interface” (paragraph [0087]).

Dependent claims 110, 134, 158 and 183 recite “providing an auction or reverse auction through the navigation interface” (paragraph [0093]).

Dependent claims 113, 137, 161 and 186 recite “displaying the advertisement within a cell of a primary navigation option, the cell within the navigation interface” (paragraph [0059]).

Dependent claims 115, 139, 163 and 188 recite “receiving one bid of the plurality of bids from a client through a web based interface” (paragraph [0088]).

Dependent claims 117, 141, 165 and 190 recite “wherein the navigation interface includes a plurality of cells corresponding to primary navigation options” (paragraph [0059]).

Dependent claims 119, 143, 167 and 192 recite “displaying a web based interface for receiving the plurality of bids” (paragraph [0088]).

Dependent claims 120, 144, 168 and 193 recite “wherein the web based interface includes client options for modifying a bid” (paragraph [0088]).

Dependent claims 121, 145, 169 and 194 recite “tracking user selection of a navigation option; and displaying a report of aggregated user selections” (paragraph [0091]).

Dependent claims 122, 146, 170 and 195 recite “reformatting content from a website to display through the navigation interface with the advertisement” (paragraph [0039]).

Dependent claims 123, 147, 172 and 197 recite “ranking bids to display advertisements in a layer at a maximum depth of the navigation interface” (paragraph [0088]).

Dependent claims 124, 148, 173 and 198 recite “ranking bids to display advertisements in a specific layer of the navigation interface” (paragraph [0088]).

Dependent claims 125, 149, 174 and 199 recite “displaying the advertisement in a primary navigation option within the navigation interface, the primary navigation option not in a cell or matrix” (paragraphs [0057]-[0059]).

Dependent claims 126, 150, 175 and 200 recite “displaying the navigation interface as an overlay over the advertisement” (paragraph [0047]).

Dependent claims 128, 152, 177 and 202 recite “receiving navigation input selections from a voice recognition system” (paragraph [0044]).

Dependent claims 129, 153, 178 and 203 recite “receiving bids, advertisements and content over the internet from a remote machine” (paragraph [0088]).

Dependent claims 130, 154, 179 and 204 recite “wherein each of the plurality of bids corresponds to a fixed time slot” (Fig. 21).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues involved in this Appeal are as follows:

- A. Whether claims 111, 135, 159 and 183 are in improper dependent form based on 37 C.F.R. § 1.75(c).
- B. Whether claims 108-205 are unpatentable under U.S.C. § 103 as obvious over U.S. Patent No. 6,571, 279 by Herz et al. (“Herz”) in view of U.S. Patent No. 6,868,525 by Szabo et al. (“Szabo”).

All of the claims do not stand or fall together. The basis for the separate patentability of the claims is set forth below.

VII. ARGUMENT

A. Overview of the Prior Art

The Examiner rejected Appellant’s claims over two references. These references are introduced below.

1. Overview of Herz

Herz discloses a location enhanced information delivery system architecture (LEIA). Herz, Abstract. This system relies on wireless communication networks and on the detection of a geographical location of a user through a network of sensors connected to the wireless communication network and deployed in the relevant geographical location. Herz, col. 2, l. 53 – col. 4, l. 35. A user who is carrying a wireless device is detected by a network and identified by a

location identifier. Herz, col. 7, l. 54 – col. 8, l. 23. The identifier is associated with a user profile. Herz, col. 8, ll. 25-36. The user profiles are utilized for displaying advertisements on billboards or similar displays based on an aggregation of profile data for users in proximity to a display on the network. Herz, col. 4, l. 49 – col. 5, l. 2 and col. 13, ll. 6-17. These displays are situated in public areas in stores, along walkways and roads. Herz, col. 4, ll. 49-53.

Herz does not disclose a system where advertisements are presented in an interactive interface such as a navigation interface or a system that is capable of receiving or processing input from a user through a display of the system. Herz also fails to disclose bidding on the displaying of advertisements that are linked with particular keywords or categories, the processing of unique inputs or use of primary navigation options, a web based interface for bidding or account management, receiving bids or input from a remote computer, a bidding system for fixed time slots, use of overlays in a navigation interface, and ranking bids for a particular layer of a hierarchical interface.

2. Overview of Szabo

Szabo discloses a system and method for generating an interface for viewing search results in a tree or taxonomical presentation. Szabo, col. 19, ll. 34-65. The organizational schema is used to alter the scope of search results to focus the search results that are most relevant to the user. Szabo, col. 21, l. 31 – col. 22, l. 2. This system relies on the use of a browser on a client computer for the generation of the user interface and communicates with a remote database server against which the searches are run. Szabo, col. 18, l. 63 – col. 19, l. 18. The tree or taxonomical structure can be displayed in combination with advertisements where the advertisements are context sensitive. Szabo, Fig. 1A, col. 36, l. 50 – col. 37, l. 18. Navigation of the interface is through the use of a pointer device. Szabo, col. 32, ll. 41-49.

Szabo does not disclose a system including bidding on display of advertisements that are linked with particular keywords or categories, the processing of unique inputs or use of primary navigation options, a web based interface for bidding or account management, receiving bids or input from a remote computer, a bidding system for fixed time slots, use of overlays in a navigation interface, and ranking bids for a particular layer of a hierarchical interface.

B. Rejection of Claims 108-205 as unpatentable under 35 U.S.C § 103 over Herz in view of Szabo

To establish a *prima facie* case of obviousness the Examiner must show that the cited references, combined, teach or suggest each of the elements of a claim. See *In re Vaek*, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991). Further, the combination of elements must be “more than the predictable use of prior art elements according to their established functions.” See *KSR International Co. v. Teleflex Inc.*, No. 04-1350 (Supreme Court, April 30, 2007).

Claims 156 and 181

a) The Cited References Do not Teach Each of the Elements of the Claims

Claims 156 and 181 includes the elements of “receiving a plurality of bids to display advertising in association with a keyword.” The Examiner has relied on Herz to teach “receiving a plurality of bids to display advertising” (Final Office Action, mailed May 11, 2007, p. 2), but has not set forth any argument that Herz teaches that these bids are in any way associated with a keyword. The cited section of Herz, in fact, teaches that “each advertiser ‘bids’ for the current user profile by specifying [a] price function.” Herz, col. 5, ll. 26-28. The Appellant has reviewed Herz and been unable to discern any part therein that teaches bidding for advertising associated with a keyword.

The Examiner states that Szabo teaches “that the plurality of bids is received in association with a keyword,” citing col. 3, ll. 17-35 of Szabo in support of this assertion. However, this section of Szabo states:

A well-recognized problem with existing search engines is the tendency to return hits for a query that are so incredibly numerous, sometimes in the hundreds, thousands, or even millions, that it is impractical for user to wade through them and find relevant results. Many users, probably the majority, would say that the existing technology returns far too much “garbage” in relation to pertinent results. This has lead to the desire among many users for an improved search engine, and in particular an improved Internet search engine. In response to the garbage problem, search engines have sought to develop unique proprietary approaches to gauging the relevance of results in relation to a user’s query. Such technologies employ algorithms for either limiting the records returned in the selection process (the search) and/or by sorting selected results from the database according to a rank or weighing, which maybe predetermined or computed on the fly. The known techniques include counting the frequency or proximity of keywords, measuring the frequency of user visits to a site or the persistence of users on that site, using human librarians to estimate the value of a site and to quantify or rank it, measuring the extent to which the site is linked to other sites through ties called “hyper-links” (see Google.com and Clever.com), measuring how much economic investment is going into a site (Thunderstone.com), taking polls of users, or even ranking relevance in certain cases according to advertiser’s willingness to bid the highest price for good position within ranked lists.

Szabo col. 3, ll. 6-35. As can be easily discerned, the cited section makes no mention of receiving bids associated with a keyword. The only mention of the term ‘keyword’ is “counting the frequency or proximity of keywords” as a technique for combating the ‘garbage problem.’ Thus, the Examiner has failed to establish that Szabo teaches or suggests this element of claims 156 and 181.

Accordingly, the Examiner has failed to establish that Herz in view of Szabo teaches this element of claims 156 and 181.

b) Herz Is Not Properly Combined with Szabo

The Appellant does not believe that the combination of Herz and Szabo is proper. The Examiner asserts that it would have been obvious to one of ordinary skill in the art to combine Herz with Szabo because “a hierarchical navigation search interface makes large quantities of information understandable” and “it is especially useful for targeted advertising.” (Final Office Action, p. 3.) In

regard to the former, the Examiner has not shown that Herz, in any embodiment, attempts to provide large quantities of information to a user. As discussed above, Szabo is an interface for managing large data returned from search results. Szabo makes clear that searching the Internet can produce large sets of results that are difficult to view and manage numbering in the thousands or even millions. Szabo, col. 3, ll. 6-15. Thus, one skilled in the art would not consider the advertisements of Herz to be large quantities of information on the scale indicated by Szabo.

In regard to the justification based on “useful for targeted advertising,” the discussion of targeted advertising in Szabo (col. 18, lines 8-14) relied upon by the Examiner does not appear to disclose any benefit related to the use of its navigation interface for targeted advertising. Rather, the section discusses the definition of “associated object” that is defined by a process of collaborative filtering. This associated object may be an advertisement. It is not clear in what manner this supports the Examiner’s assertion that the hierarchical presentation of search results is advantageous for targeted advertising. Thus, Appellant believes the Examiner has failed to set forth a proper motivation for the combination of the hierarchical presentation of search results with the location tracking and display system of Herz.

Further, one of ordinary skill in the art would not think to combine the teachings of Herz with Szabo, because the modification of the primary reference of Herz that the Examiner seeks in light of Szabo requires the addition of a graphical user interface and information retrieval system for as search engine to the elaborate tracking and display system of Herz, which determines the location of individuals through tracking devices and sensors and selects content for display to the these individuals. Such a modification would require the addition of a user input device (i.e., a pointer device) and support for a browser application to offer a search engine. See generally, Szabo col. 1, ll. 1-9, ll. 47-65, col. 18, l. 63 – col. 19, l. 18 and col. 32, ll. 41-49.

The system of Herz provides advertisements to users through electronic displays such as billboards positioned in stores, along walkways and roads. Herz, col. 4, ll. 49-53. These are not locations where a user would interact with the display or where input devices are appropriate. The Appellant has not been able to discern any teaching of Herz indicting that the displays are capable of receiving user input. Further, the Appellant has not discerned any teaching indicating Herz is capable of processing user input or transmitting it from an input device to a processor. The addition of such an elaborate user interface and feedback system changes the fundamental operating principle of Herz which is aimed at improving the utility of displays to make them more cost effective by providing advertising that is directed toward individuals in the vicinity of the display. See Herz, col. 10, l. 64 – col. 11, l.10 and MPEP § 2143.02 (IV). The Proposed Modification Cannot Change The Principle of Operation of a Reference.

No one skilled in the art would combine these references as proposed by the Examiner based on their disclosures or that which is commonly known in the art. The computer interface system of Szabo is predicated on the interactive navigation of large amounts of information in a traditional personal computer system setting such as a desktop or workstation. See Abstract Szabo. Herz requires location information from user terminals such as positioning devices or cell phones that track a user position in the real world. Herz, col. 1, ll. 46-64. Herz discloses only a passive display of information. Herz, col. 10, l. 52 – col. 11, l. 10. Thus, it is nonsensical to provide a navigation interface to a system with no means or need for interaction, much less a navigation system that is designed for a conventional computer paradigm and not the relevant embodiments disclosed by Herz related to advertising in commercial or public spaces. Therefore, the Appellant believes that the Examiner cannot properly combine Herz and Szabo to teach the elements of the claims.

Appellants note that these arguments are consistent with the Supreme Court's recent decision in *See KSR International Co. v. Teleflex Inc.*, No. 04-1350 (Supreme Court, April 30, 2007).

Appellants are not relying on a bright line or inflexible interpretation of the teaching suggestion or motivation (TSM) test. Rather, the Appellants have set forth that one skilled in the art would not have combined the cited references because the proposed combination is not the mere combination of known elements according to their well-known or established functions. The proposed combination is a substantial redesign of the primary reference that would not be obvious to one skilled in the art.

c) Herz Is Not Analogous Art

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of Appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). These claims are directed to a navigation interface and the presentation of content and advertisements related to keywords through a navigation interface. As discussed above, Herz does not include a navigation interface nor is it capable of processing user input. Thus, Herz is not pertinent to the problem with which the invention is concerned, because it provides no teaching related to navigation interfaces or the use of keywords. Therefore, the Appellant believes that Herz is not properly relied upon by the Examiner especially as the primary reference.

d) Conclusion

For the reasons set forth above, the Appellant believes that the Examiner has failed to establish that Herz can be properly combined with Szabo to teach or suggest each of the elements of claims 156 and 181. Further, claims 159, 160, 162, 164, 166, 176, 180, 184, 185, 187, 189, 191, 201 and 205 depend from claims 156 and 181, respectively, and incorporate the limitations thereof. Thus,

at least for the reasons mentioned above, these claims are also not obvious over Herz in view of Szabo. Accordingly, it is requested that the rejection of these claims be overturned.

Claims 108 and 132

These claims include elements similar to those of claims 156 and 181, including the elements of “receiving a plurality of bids to display advertising in association with a keyword.” Thus, at least for the reasons mentioned above in regard to claims 156 and 181, these claims are not obvious over Herz in view of Szabo. The Appellant believes these claims are separately patentable for the reasons below.

Claims 108 and 132 include the elements of “displaying content via an internet that is associated with the advertisement, any one of the content or the advertisement formatted for navigation with unique inputs.” The Examiner has not alleged and the Appellant has been unable to discern any part of the primary reference, Herz, that teaches or suggests any content or advertisement that is navigable, much less formatted for navigation with unique inputs. The Examiner has relied on the secondary reference Szabo to cure this defect of Herz. The Examiner has asserted that the hyperlinks discussed in col. 2, ll. 56-68 have “a unique location, so activating it generates a unique input.” (Final Office Action, footnote 1 on p. 3.) However, this interpretation of the term “unique input” is contrary to the plain meaning of the term and how one skilled in the art would understand it as used in the context of the claim. Hyperlinks are defined as “*Computer Science* [a] segment of text or a graphical item that serves as a cross-reference between parts of a hypertext document or between files or hypertext documents. Also called *hotlink*, *hyperlink*.” See hyperlink, Dictionary.com, *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004. <http://dictionary.reference.com/browse/hyperlink> (accessed: June 05, 2007). An

input is defined as “*Computer Science* [i]nformation put into a communications system for transmission or into a computer system for processing.” See input, Dictionary.com, *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004. <http://dictionary.reference.com/browse/input> (accessed: June 05, 2007). A hyperlink is not information put *into* a computer system. The selection of a hyperlink by a user is based on an input from a mouse or similar pointer device. Such devices do not generate an input that is unique in any sense. Therefore, a hyperlink cannot be said to be “formatted for navigation by unique inputs.” Thus, the Examiner has failed to establish that Herz in view of Szabo teaches or suggests these elements of claims 108 and 132.

For the reasons set forth above, the Appellant believes that the Examiner has failed to establish that Herz can be properly combined with Szabo to teach or suggest each of the elements of claims 108 and 132. Further, claims 111, 112, 114, 116, 118, 127, 131, 135, 136, 138, 140, 142, 151 and 155 depend from claims 108 and 132, respectively, and incorporate the limitations thereof. Thus, at least for the reasons mentioned above, the Examiner has failed to establish a *prima facie* case that these claims are obvious over Herz in view of Szabo. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 157 and 182

These claims depend from independent claims 156 and 181, respectively, and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 156 and 181, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

In regard to claims 157 and 182, these claims include the elements of “providing an account management interface to a user through the navigation interface.” The Examiner has relied on Herz, col. 6, l. 27 to teach these elements of claims 157 and 182. The cited section of Herz, col. 6, ll. 27-32 discusses the maintenance of user profiles. However, there is no mention of the user profiles being managed through the display subsystem of the LEIA system. Thus, there is no teaching that the management of these profiles would be possible through the same navigation interface that would display the advertisement. One skilled in the art, reading this section, would assume that the profiles would be managed through a separate interface, because, as discussed above, the system of Herz is not designed to process or receive any user input mechanism from its display subsystem. Thus, the Examiner has failed to establish that Herz in view of Szabo teaches or suggests each of the elements of claims 157 and 182. Therefore, the Examiner has not established a *prima facie* case of obviousness for these claims. Accordingly, it is requested that the obviousness rejection of claims 157 and 182 be overturned.

Claims 109 and 133

These claims depend from independent claims 108 and 132, respectively, and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 108 and 132, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

In regard to claims 109 and 133, these claims include the elements of “providing an account management interface to a user through the navigation interface.” Thus, for the reasons mentioned above in regard to claims 157 and 182, the Examiner has failed to establish that this element is taught

or suggested by Herz in view of Szabo. Accordingly, it is requested that the obviousness rejection of claims 109 and 133 be overturned.

Claims 158 and 183

These claims depend from independent claims 156 and 181, respectively, and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 156 and 181, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

In regard to claims 158 and 183, these claims includes the elements of “providing an auction or reverse auction through the navigation interface” The Examiner has relied on Herz, col. 29, ll. 6 and 7 to teach these elements of claims 110 and 135. The cited section of Herz discusses “an auction-like bidding algorithm to select data for display.” However, there is no mention of the auction being presented through a display of the LEIA system. Thus, there is no teaching that the auction would be presented through the same navigation interface that would display the advertisement. One skilled in the art, reading this section, would assume that the auction would be managed through a separate interface, because, as discussed above, the system of Herz does not provide any user input mechanism for its displays in the LEIA system. Thus, the Examiner has failed to establish that Herz in view of Szabo teaches or suggests each of the elements of claims 158 and 183. Therefore, the Examiner has not established a *prima facie* case of obviousness for these claims. Accordingly, it is requested that the obviousness rejection of claims 158 and 183 be overturned.

Claims 110 and 134

These claims depend from independent claims 108 and 132 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 108 and 132, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

In addition, these claims include the elements similar to those of claims 158 and 183, including the elements of “providing an auction or reverse auction through the navigation interface.” Thus, for the reasons mentioned above in regard to claims 158 and 183, the Examiner has failed to establish that Herz in view of Szabo teaches or suggests each of the elements of claims 110 and 134. Accordingly, it is requested that the obviousness rejection of claims 110 and 134 be overturned.

Claims 160 and 185

These claims depend from independent claims 156 and 181 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 156 and 181, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner appears to acknowledge that Herz fails to teach the additional elements of these claims and has instead rejected these claims based on Szabo. (Final Office Action, p. 4.) The Examiner has cited col. 45, ll. 45-49 as teaching the elements of these claims. The claims recite “retaining user data for each of a plurality of users of the navigation interface; and customizing the display of the navigation interface based on the user data.” However, the cited section of Szabo does not appear to teach these elements of the claims. Rather, the cited section describes a Site

Mapping™ system that provides a uniform user interfaces having “common mapping and navigation characteristics” across a group of websites. See Szabo, col. 45, ll. 45-50. However, these user interfaces are provided to all users of the Site Mapping™ system and are not customized for any particular individual. Thus, the Site Mapping™ system does not appear to utilize any user data in the generation of the user interfaces. Therefore, the Examiner has failed to establish that Herz in view of Szabo teaches or suggests each of the elements of these claims. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for these claims and it is requested that the obviousness rejection of these claims be overturned.

Claims 112 and 136

These claims depend from independent claims 108 and 132 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 108 and 132, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner appears to acknowledge that Herz fails to teach the additional elements of these claims and has instead rejected these claims based on Szabo. (Final Office Action, p. 4.) The Examiner has cited col. 45, ll. 45-49 as teaching the elements of these claims. These claims, similar to claims 160 and 185, recite “retaining user data for each of a plurality of users of the navigation interface; and customizing the display of the navigation interface based on the user data.” Thus, for the reasons mentioned above in regard to claims 160 and 185, the Examiner has failed to establish that Herz in view of Szabo teaches or suggests each of the elements of these claims. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for these claims and it is requested that the obviousness rejection of these claims be overturned.

Claims 161 and 186

These claims depend from independent claims 156 and 181 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 156 and 181, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner appears to acknowledge that Herz fails to teach the additional elements of these claims and has instead rejected these claims based on Szabo. (Final Office Action, p. 3.) However, the Examiner has not cited specific sections of Szabo in support of this rejection and it is unclear whether the Examiner believes that these elements are expressly or inherently taught. If “relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” See *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The additional elements of these claims include “displaying the advertisement within a cell of a primary navigation option, the cell within the navigation interface.” The Appellants have been unable to discern any part of Szabo that explicitly teaches these additional elements. Further, the Examiner has not established any explanation in support of his assertion of inherency and thus has failed to meet his burden in establishing inherency and therefore obviousness. The Appellant has been unable to discern any part of Herz or Szabo that discloses the display of an advertisement through a cell, much less a cell of a primary navigation option. In regard to the term “primary navigation option,” the Appellant has chosen to be his own lexicographer by clearly providing a definition of the term in paragraph [0057] of the specification. The Examiner does not appear to take

this into consideration in his rejection of this claim. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for these claims. Accordingly, it is requested that the obviousness rejection of claims 161 and 186 be overturned.

Claims 113 and 137

These claims depend from independent claims 108 and 132 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 108 and 132, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

Similar to claim 161 and 186, these claims include “displaying the advertisement within a cell of a primary navigation option, the cell within the navigation interface.” Thus, for the reasons set forth above in regard to claims 161 and 186, the Examiner has not established that Herz in view of Szabo teaches or suggests each of the elements of these claims. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 113 and 137. Accordingly, it is requested that the obviousness rejection of claims be overturned.

Claims 163, 167, 188 and 192

These claims depend from independent claims 156 and 181 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 156 and 181, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner has rejected these claims based on Herz (Final Office Action, p. 3) without providing any specific argument or citation to Herz in support of the rejection. It is unclear whether

the Examiner believes these elements to be explicitly or inherently taught by Herz. These claims include “receiving one bid of the plurality of bids from a client through a web based interface” or “displaying a web based interface for receiving the plurality of bids.” The Appellant has reviewed Herz but has been unable to discern any part therein that describes an interface for a bidding process. The section of Herz cited by the Examiner in the discussion of the independent claims in regard to bidding (col. 5, ll. 15-30) makes no mention of the method by which such bids would be received or managed. Further, the Examiner has failed to claim or set forth reasoning in support of these elements being inherently taught by Herz. Bids could be received by direct personal contact, email, telephone or similar manner of communication. Thus, the system of Herz does not necessarily include a web based interface. The Appellant has been unable to discern and the Examiner has not relied on any part of Szabo to cure these defects of Herz. Szabo is equally silent on the issue of an interface for making or placing bids. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for these claims. Accordingly, it is requested that the obviousness rejection of claims 163, 167, 188 and 192 be overturned.

Claims 115, 119, 139 and 143

These claims depend from independent claims 108 and 132 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 108 and 132, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner has rejected these claims based on Herz (Final Office Action, p. 3) without providing any specific argument or citation to Herz in support of the rejection. Similar to claims 163, 167, 188 and 192, these claims include “receiving one bid of the plurality of bids from a client

through a web based interface” or “displaying a web based interface for receiving the plurality of bids.” Thus, for the reasons mentioned above in regard to claims 163, 167, 88 and 192, the Examiner has failed to establish that Herz in view of Szabo teaches or suggests each of the elements of these claims. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for these claims. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 165 and 190

These claims depend from independent claims 156 and 181 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 156, and 181, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner has rejected these claims based on Szabo thereby implying that Herz fails to teach these elements (Final Office Action, p. 3) without providing any specific argument or citation to Szabo in support of the rejection. These claims include “wherein the navigation interface includes a plurality of cells corresponding to primary navigation options.” The Appellant has reviewed Szabo but has been unable to discern any part therein that describes a navigation interface with a plurality of cells and specifically where the plurality of cells correspond to primary navigation options. As discussed above, the interface of Szabo is a tree or taxonomical display. Szabo, col. 19, ll. 34-65. The Appellant has been unable to discern any use of a plurality of cells that correspond to primary navigation options as defined by the Appellant (see discussion of claims 158 and 183 above). Thus, the Appellant has been unable to discern any part of Herz or Szabo that discloses a navigation interface providing a plurality of cells, much less cells corresponding to a primary navigation option.

Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 165 and 190. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 117 and 141

These claims depend from independent claims 108 and 132 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 108, and 132, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner has rejected these claims based on Szabo thereby implying that Herz fails to teach these elements (Final Office Action, p. 3) without providing any specific argument or citation to Szabo in support of the rejection. Similar to claims 165 and 190, these claims include “wherein the navigation interface includes a plurality of cells corresponding to primary navigation options.” Thus, for the reasons set forth above in regard to claims 165 and 190, the Examiner has not established that Herz in view of Szabo teaches the elements of these claims. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 117 and 141. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 168 and 193

These claims depend from independent claims 156 and 181 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 156 and 181, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner has rejected these claims based on Herz (Final Office Action, p. 3) without providing any specific argument or citation to Herz in support of the rejection. These claims include “wherein the web based interface includes client options for modifying a bid.” The Appellant has reviewed Herz but has been unable to discern any part therein that describes a web based interface, much less a web based interface that provides client options for modifying a bid.” As discussed above in regard to claims 115, 119, 139, 143, 163, 167, 188 and 192, Herz does not disclose a web based interface for managing or making bids. Thus, Herz cannot teach the elements of these claims, which further build on such an interface. Thus, the Examiner has failed to establish a *prima facie* case of obviousness based on Herz and Szabo for claims 168 and 193. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 120 and 144

These claims depend from independent claims 108 and 132 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 108 and 132, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner has rejected these claims based on Herz (Final Office Action, p. 3) without providing any specific argument or citation to Herz in support of the rejection. Similar to claims 168 and 193, these claims include “wherein the web based interface includes client options for modifying a bid.” Thus, for the reasons mentioned in regard to claims 168 and 193, the Examiner has failed to establish a *prima facie* case of obviousness based on Herz and Szabo for claims 120 and 144. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 169 and 194

These claims depend from independent claims 156 and 181 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 156 and 181, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner has acknowledged that neither Herz nor Szabo teaches or suggests these elements of claim 169 and 194. The Examiner relies on Official Notice that “displaying reports of targeting data... [was] well known and therefore obvious at the time of the invention.” The Examiner offers no separate reasoning providing a motivation to combine a report with the other elements of the claims. Rather, it appears the Examiner has taken Official Notice that it would be obvious to combine these elements. The Appellant does not believe that combining reporting of tracked user navigation with ranking and bidding for the placement of an advertisement in a navigation system is capable of instant and unquestionable demonstration. Rather, reporting is typically associated with spreadsheet applications (e.g., Microsoft Excel®) and similar accounting applications that do not have the capability of tracking input other than direct user interaction with the application. Thus, the Examiner has not properly taken Official Notice. Therefore, the Examiner has not established that each of the elements of claims 169 and 194 is taught or suggested to establish a *prima facie* case of obviousness. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 121 and 145

These claims depend from independent claims 108 and 132 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 108 and 132, these claims

are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner has acknowledged that neither Herz nor Szabo teaches or suggests these elements of claim 121 and 145. The Examiner relies on Official Notice to teach the same elements as present in claims 169 and 194. Thus, for the reasons mentioned above in regard to claims 169 and 194, the Official Notice relied on to teach these claims is improper. Therefore, the Examiner has not established that each of the elements of claims 121 and 145 is taught or suggested to establish a *prima facie* case of obviousness. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 170 and 195

These claims depend from independent claims 156 and 181 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 156 and 181, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner appears to acknowledge that Herz fails to teach or suggest the elements of these claims and has rejected these claims based on Szabo. (Final Office Action, p. 3.) It is unclear if the Examiner is relying on explicit or inherent disclosure from Szabo. These claims include “reformatting content from a website to display through the navigation interface with the advertisement.” The Appellant has reviewed Szabo, but has been unable to discern any reformatting of a website. Rather, Szabo generates a tree or taxonomical display of search results. Szabo, col. 21, l. 31 – col. 22, l. 2. The Examiner has not established any explanation in support of an assertion of inherency and thus has failed to meet his burden in establishing inherency and therefore obviousness.

The Appellant has been unable to discern any part of Herz or Szabo that discloses the reformatting of website data. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 170 and 195. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 122 and 146

These claims depend from independent claims 108 and 132 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 108 and 132, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner appears to acknowledge that Herz fails to teach or suggest the elements of these claims and has rejected these claim based on Szabo. (Final Office Action, p. 3.) Similar to claims 170 and 195, these claims include “reformatting content from a website to display through the navigation interface with the advertisement.” Thus, for the reasons mentioned in regard to claims 170 and 195, the Examiner has failed to establish a *prima facie* case of obviousness for claims 122 and 146. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 171 and 196

These claims depend from independent claims 156 and 181 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 156 and 181, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner appears to acknowledge that Herz fails to teach the elements of these claims and has rejected these claims based on Szabo. (Final Office Action, p. 3.) It is unclear if the Examiner is relying on explicit or inherent disclosure from Szabo. These claims include “receiving a unique input to select a primary navigation option corresponding to the advertisement.” The Appellant has reviewed Szabo, but has been unable to discern any teaching of the processing of a unique input to select a primary navigation option. Rather, Szabo generates a tree or taxonomical display of search results. Szabo, col. 21, l. 31 – col. 22, l. 2. The tree is composed of hyperlinks, which the Examiner equates with unique inputs. (Final Office Action, p. 3.) However, as set forth in the discussion above in regard to claims 108, 132, 161 and 186, the Examiner has not established that a hyperlink or any other disclosure of Herz in view of Szabo teaches or suggests the terms “unique input” and “primary navigation options.” Thus, a hyperlink is not a unique input and the Examiner has failed to show an explicit teaching of a primary navigation option. The Examiner has not established any explanation in support of an assertion of inherency and thus has failed to meet his burden in establishing inherency and therefore obviousness. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 171 and 196. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 172 and 197

These claims depend from independent claims 156 and 181 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 156 and 181, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner appears to acknowledge that Herz fails to teach the elements of these claims and has rejected these claims based on Szabo. (Final Office Action, p. 3.) It is unclear if the Examiner is relying on explicit or inherent disclosure from Szabo. These claims include “ranking bids to display advertisements in a layer at a maximum depth of the navigation interface.” The Appellant has reviewed Szabo, but has been unable to discern any teaching of the processing of ranking bids for display at a maximum depth of an interface. Rather, Szabo generates a tree or taxonomical display of search results having a single layer or depth. Szabo, col. 21, l. 31 – col. 22, l. 2. Thus, bids cannot be made for a particular depth, much less a maximum depth, because only a single depth exists. The Examiner argues that a single depth inherently teaches a maximum layer depth. However, one skilled in the art would understand that if a single layer exists then it is unnecessary to associate bids with any layer. Thus, inherency is not established, because it is not necessitated by having a single layer. Herz fails to cure this defect of Szabo. Herz also does not teach or suggest an interface with multiple levels. Therefore, it cannot rank advertisements for a particular level. Thus, the Examiner has failed to establish that Herz in view of Szabo teaches or suggest each of the elements of claims 172 and 197. Accordingly, the Examiner has not established a *prima facie* case of obviousness for these claims and it is requested that the obviousness rejection of these claims be overturned.

Claims 123 and 147

These claims depend from independent claims 108 and 132 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 108 and 132, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner appears to acknowledge that Herz fails to teach the elements of these claims and has rejected these claims based on an inherent disclosure from Szabo. (Final Office Action, p. 3.) Similar to claims, 172 and 197, these claims include “ranking bids to display advertisements in a layer at a maximum depth of the navigation interface.” Thus, for the reasons mentioned above in regard to claims 172 and 197, the Examiner has failed to establish that Herz in view of Szabo teaches or suggest each of the elements of claims 123 and 147. Accordingly, the Examiner has not established a *prima facie* case of obviousness for these claims and it is requested that the obviousness rejection of these claims be overturned.

Claims 173 and 198

These claims depend from independent claims 156 and 181 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 156 and 181, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner appears to acknowledge that Herz fails to teach the elements of these claims and has rejected these claims based on an inherent disclosure from Szabo. (Final Office Action, p. 3.) These claims include “ranking bids to display advertisements in a specific layer of the navigation interface.” The Appellant has reviewed Szabo, but has been unable to discern any teaching of the processing of ranking bids for display at a specific depth of an interface. Rather, Szabo generates a tree or taxonomical display of search results having a single layer or depth (as acknowledged by the Examiner). Szabo, col. 21, l. 31 – col. 22, l. 2. Thus, bids cannot be made for a particular depth, because only a single layer exists. The Examiner argues that a single depth inherently teaches a particular depth. However, one skilled in the art would understand that if a single layer exists then it

is unnecessary to associate bids with any layer. Thus, inherency is not established, because it is not necessitated by having a single layer. Herz fails to cure this defect of Szabo. Herz also does not teach or suggest an interface with multiple levels. Therefore, it cannot rank advertisements for a particular level. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 173 and 198. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 124 and 148

These claims depend from independent claims 108 and 132 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 108 and 132, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner appears to acknowledge that Herz fails to teach the elements of these claims and has rejected these claims based on an inherent disclosure from Szabo. (Final Office Action, p. 3.) Similar to claims 173 and 198, these claims include “ranking bids to display advertisements in a specific layer of the navigation interface.” For the reasons mentioned above in regard to claims 173 and 198, these claims are not taught or suggested by Herz in view of Szabo. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 124 and 148. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 174 and 199

These claims depend from independent claims 156 and 181 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 156 and 181, these claims

are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner appears to acknowledge that Herz fails to teach or suggest the elements of these claims and has rejected these claims based on Szabo. (Final Office Action, p. 3.) It is unclear whether the Examiner believes Szabo explicitly or inherently teaches the elements of these claims. These claims include “displaying the advertisement in a primary navigation option within the navigation interface, the primary navigation option not in a cell or matrix.” However, the Examiner has not cited any section of Szabo to support the rejection or established any explanation in support of an assertion of inherency and thus has failed to meet his burden in establishing inherency and therefore obviousness. The Appellant has been unable to discern any part of Herz or Szabo that discloses the display of an advertisement through a primary navigation option as defined by the Appellant (see discussion above for primary navigation option in regard to claims 113, 137, 161 and 186). Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 174 and 199. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 125 and 149

These claims depend from independent claims 108 and 132 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 108 and 132, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner appears to acknowledge that Herz fails to teach or suggest the elements of these claims and has rejected these claims based on Szabo. (Final Office Action, p. 3.) It is unclear

whether the Examiner believes Szabo explicitly or inherently teaches the elements of these claims. Similar to claims 174 and 199, these claims include “displaying the advertisement in a primary navigation option within the navigation interface, the primary navigation option not in a cell or matrix.” Thus, for the reasons set forth in regard to claims 174 and 199, these claims are not obvious over Herz in view of Szabo. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 125 and 149. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 175 and 200

These claims depend from independent claims 156 and 181 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 156 and 181, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner appears to acknowledge that Herz fails to teach or suggest the elements of these claims and has rejected this claim based on Szabo. (Final Office Action, p. 4.) The Examiner has cited col. 45, lines 45-59 as teaching the elements of these claims. These claims include “displaying the navigation interface as an overlay over the advertisement.” The Appellant has reviewed the cited section of Szabo (col. 45, ll. 45-59), but has been unable to discern any teaching of the overlaying an interface over an advertisement. Rather, the cited section of Szabo discusses Site Mapping™, which appears to be wholly unrelated to the subject matter of the claims. Further, Szabo generates a tree or taxonomical display of search results. Szabo, col. 21, l. 31 – col. 22, l. 2. Ads are placed as banner ads (see Szabo Fig. 1A, lower left hand corner). Herz fails to cure this defect of Szabo. Herz does not teach or suggest a navigation interface. Thus, it cannot teach overlaying a

navigation interface over an advertisement. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 175 and 200. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 126 and 150

These claims depend from independent claims 108 and 132 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 108 and 132, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner appears to acknowledge that Herz fails to teach or suggest the elements of these claims and has rejected this claim based on Szabo. (Final Office Action, p. 4.) The Examiner has cited col. 45, lines 45-59 as teaching the elements of these claims. Similar to claims 175 and 200, these claims include “displaying the navigation interface as an overlay over the advertisement.” Thus, for the reasons mentioned above in regard to claims 175 and 200, these claims are not taught or suggested by Herz in view of Szabo. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 126 and 150. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 177 and 202

These claims depend from independent claims 156 and 181 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 156 and 181, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner has acknowledged that neither Herz nor Szabo teaches or suggests these elements of claims 177 and 202. (Final Office Action, p. 4.) The Examiner relies on Official Notice that “voice recognition inputs (by the blind, for example) were well known and therefore obvious at the time of the invention.” The Examiner offers no separate reasoning providing a motivation to combine voice recognition with the other elements of the claims. Rather, it appears the Examiner has taken Official Notice that it would be obvious to combine these elements. The Appellant does not believe that combining voice recognition with the system of Herz further combined with Szabo is obvious to one skilled in the art. The system of Herz is designed to track user position and has no need of any input from a user including voice recognition input. Szabo is a graphical user interface that is designed for use with a pointer device. Voice recognition does not translate into a pointing system. Thus, the Examiner has not properly taken Official Notice. Therefore, the Examiner has not established that each of the elements of these claims is taught or suggested by the cited references or Official Notice to establish a *prima facie* case of obviousness. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 128 and 152

These claims depend from independent claims 108 and 132 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 108 and 132, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner has acknowledged that neither Herz nor Szabo teaches or suggests these elements of claims 128 and 152. (Final Office Action, p. 4.) The Examiner relies on Official Notice that “voice recognition inputs (by the blind, for example) were well known and therefore obvious at

the time of the invention.” These claims include elements similar to those of claims 177 and 202 and are not taught or suggested by the Official notice or cited references for the reasons mentioned above in regard to claims 177 and 202. Therefore, the Examiner has not established a *prima facie* case of obviousness for claims 128 and 152. Accordingly, it is requested that the obviousness rejection of these claims be overturned.

Claims 178 and 203

These claims depend from independent claims 156 and 181 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 156 and 181, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner has rejected these claims based on Herz. (Final Office Action, p. 3.) However, the Examiner has not cited any section of Herz as teaching the elements of these claims including “receiving bids, advertisements and content over the internet from a remote machine.” The Appellant has reviewed Herz and Szabo but been unable to discern any part therein that teaches these elements. Rather, as discussed above, these references are silent as to the manner in which any bids would be received or managed. These references do not inherently teach the use of a remote machine for this purpose as it is possible that bids are received by phone, in person or similarly received such that it is not necessary that they are received from a remote machine. Therefore, the Examiner has not established a *prima facie* case of obviousness for claims 178 and 203. Accordingly, it is requested that the obviousness rejection of claims 178 and 203 be overturned.

Claims 129 and 153

These claims depend from independent claims 108 and 132 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 108 and 132, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner has rejected these claims based on Herz. (Final Office Action, p. 3.) However, the Examiner has not cited any section of Herz as teaching the elements of these claims including “receiving bids, advertisements and content over the internet from a remote machine.” These elements are similar to those of claims 178 and 203 and thus for the reasons mentioned in regard to those claims, claims 129 and 153 are not taught or suggested by Herz in view of Szabo. Therefore, the Examiner has not established a *prima facie* case of obviousness for claims 129 and 153. Accordingly, it is requested that the obviousness rejection of claims 129 and 153 be overturned.

Claims 179 and 204

These claims depend from independent claims 156 and 181 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 156 and 181, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner has rejected these claims based on Herz. (Final Office Action, p. 3.) The Examiner cites Herz col. 11, l. 22-26 as teaching the elements of these claims, which include “wherein each of the plurality of bids corresponds to a fixed time slot.” However, the cited section of Herz discusses the pricing of advertisement time slots by conventional television programming and

not associating bids with time slots as claimed. This section of Herz discusses the practice of pricing time slots to contrast the practice with the real-time bidding on user profiles employed with the LEIA system of Herz. See Herz, col. 11, l. 22-32. Thus, the Examiner has failed to properly support this rejection and establish a *prima facie* case of obviousness. Accordingly, it is requested that the obviousness rejection of claim 179 and 204 be overturned.

Claims 130 and 154

These claims depend from independent claims 108 and 132 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to claims 108 and 132, these claims are not obvious over Herz in view of Szabo. In addition, the Appellant believes these claims are separately patentable for the following reasons.

The Examiner has rejected these claims based on Herz. (Final Office Action, p. 3.) The Examiner cites Herz col. 11, l. 22-26 as teaching the elements of these claims, which similar to claims 179 and 204 include “wherein each of the plurality of bids corresponds to a fixed time slot.” Thus, for the reasons mentioned above in regard to claims 179 and 204, these claims are not taught or suggest by Herz in view of Szabo. Therefore, the Examiner has failed to properly support this rejection and establish a *prima facie* case of obviousness. Accordingly, it is requested that the obviousness rejection of claim 130 and 154 be overturned.

C. Objection to Claims 111, 135, 159 and 183 as in Improper Dependent Form **Based on 37 C.F.R. § 1.75(c)**

The Examiner rejects claims 111, 135, 159 and 183 under 37 C.F.R. § 1.75(c) as in improper dependent form. The Examiner alleges that these dependent claims do not further limit their respective independent claims. The Examiner cites MPEP §§ 2106.01, 2164.08 and 35 U.S.C. § 112,

4th paragraph in support of this position, stating that the elements of these claims do not add a step or structure and are nonfunctional descriptive material.

The Examiner has clearly failed to apply the “infringement test” associated with 35 U.S.C. § 112, 4th. The test of whether a claim is a proper dependent claim is set forth in MPEP § 608.01(n) – Infringement Test:

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

A dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope.

Thus, for example, if claim 1 recites the combination of elements A, B, C, and D, a claim reciting the structure of claim 1 in which D was omitted or replaced by E would not be a proper dependent claim, even though it placed further limitations on the remaining elements or added still other elements.

These claims include the elements of “wherein the keyword is a category.” Thus, the elements of these claims do not seek to omit “keywords” or replace them. Rather, they narrow the “keywords” to those that are also “categories.” One skilled in the art would understand that a “keyword” can be any word. Whereas, a “category” defines a group or collection thus limiting “keywords.” The appropriate definition of keyword for the context of these claims is “[a] word used as a reference point for finding other words or information.” See keyword, Dictionary.com, *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004.

<http://dictionary.reference.com/browse/keyword> (accessed: June 05, 2007). In contrast the appropriate definition of category for the context of these claims is “[a] specifically defined division in a system of

classification; a class.” See category, Dictionary.com, *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004.

<http://dictionary.reference.com/browse/category> (accessed: June 05, 2007). Thus, these claims properly depend from the independent claims. Accordingly, it is requested that the objection to these claims be overturned.

In conclusion, the Appellant respectfully requests that the Board overturn the rejection of claims 1-20.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN



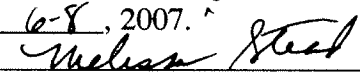
Dated: June 8, 2007

By: _____
Jonathan S. Miller Reg. No. 48,534

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025
(310) 207-3800

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this paper is being transmitted online via EFS Web to the Patent and Trademark Office, Commissioner for Patents, Post Office Box 1450, Alexandria, Virginia 22313-1450, on

6-8, 2007. 

Melissa Stead 6-8, 2007

VIII. CLAIMS APPENDIX

The claims involved in this Appeal are as follows:

1 - 107 (Canceled)

108. (Previously Presented) A method comprising:

receiving a plurality of bids to display advertising in association with a keyword;

ranking the plurality of bids based on at least one criterion;

displaying an advertisement associated with a highest ranked bid of the plurality of bids with the keyword in a navigation interface, the navigation interface having a plurality of increasingly specific hierarchical layers; and

displaying content via an internet that is associated with the advertisement, any one of the content or the advertisement formatted for navigation with unique inputs.

109. (Previously Presented) The method of claim 108, further comprising:

providing an account management interface to a user through the navigation interface.

110. (Previously Presented) The method of claim 108, further comprising:

providing an auction or reverse auction through the navigation interface.

111. (Previously Presented) The method of claim 108, wherein the keyword is a category.

112. (Previously Presented) The method of claim 108, further comprising:

retaining user data for each of a plurality of users of the navigation interface; and

customizing the display of the navigation interface based on the user data.

113. (Previously Presented) The method of claim 108, wherein displaying the advertising comprises:

displaying the advertisement within a cell of a primary navigation option, the cell within the navigation interface.

114. (Previously Presented) The method of claim 108, further comprising:

displaying the content simultaneous with the advertisement.

115. (Previously Presented) The method of claim 108, further comprising:

receiving one bid of the plurality of bids from a client through a web based interface.

116. (Previously Presented) The method of claim 108, wherein displaying the advertisement is through a user terminal which is any one of an interactive television system, web appliance, computer system or wireless device.

117. (Previously Presented) The method of claim 108, wherein the navigation interface includes a plurality of cells corresponding to primary navigation options.

118. (Previously Presented) The method of claim 108, further comprising:

receiving a selection of a unique navigation option from a remote control or a pointer device.

119. (Previously Presented) The method of claim 108, further comprising:

displaying a web based interface for receiving the plurality of bids.

120. (Previously Presented) The method of claim 119, wherein the web based interface includes client options for modifying a bid.

121. (Previously Presented) The method of claim 108, further comprising:
tracking user selection of a navigation option; and
displaying a report of aggregated user selections.

122. (Previously Presented) The method of claim 108, further comprising:
reformatting content from a website to display through the navigation interface with the advertisement.

123. (Previously Presented) The method of claim 108, further comprising:
ranking bids to display advertisements in a layer at a maximum depth of the navigation interface.

124. (Previously Presented) The method of claim 108, further comprising:
ranking bids to display advertisements in a specific layer of the navigation interface.

125. (Previously Presented) The method of claim 108, wherein displaying the advertising comprises:

displaying the advertisement in a primary navigation option within the navigation interface,
the primary navigation option not in a cell or matrix.

126. (Previously Presented) The method of claim 108, further comprising:

displaying the navigation interface as an overlay over the advertisement.

127. (Previously Presented) The method of claim 108, further comprising:

displaying the content simultaneous with the advertisement, the content including any one of audio content or video content.

128. (Previously Presented) The method of claim 108, further comprising:

receiving navigation input selections from a voice recognition system.

129. (Previously Presented) The method of claim 108, further comprising:

receiving bids, advertisements and content over the internet from a remote machine.

130. (Previously Presented) The method of claim 108, wherein each of the plurality of bids corresponds to a fixed time slot.

131. (Previously Presented) The method of claim 108, further comprising:

tracking user navigation for a pay-for-performance system.

132. (Previously Presented) A machine readable medium having instructions stored therein, which when executed cause a machine to perform a set of operations comprising:

receiving a plurality of bids to display advertising in association with a keyword;

ranking the plurality of bids based on at least one criterion;

displaying an advertisement associated with a highest ranked bid of the plurality of bids with the keyword in a navigation interface, the navigation interface having a plurality of increasingly specific hierarchical layers; and

displaying content via an internet that is associated with the advertisement, any one of the content or the advertisement formatted for navigation with unique inputs.

133. (Previously Presented) The machine readable medium of claim 132, having further instructions stored therein, which when executed cause the machine to perform further operations, comprising:

providing an account management interface to a user through the navigation interface.

134. (Previously Presented) The machine readable medium of claim 132, having further instructions stored therein, which when executed cause the machine to perform further operations, comprising:

providing an auction or reverse auction through the navigation interface.

135. (Previously Presented) The machine readable medium of claim 132, wherein the keyword is a category.

136. (Previously Presented) The machine readable medium of claim 132, having further instructions stored therein, which when executed cause the machine to perform further operations, comprising:

retaining user data for each of a plurality of users of the navigation interface; and
customizing the display of the navigation interface based on the user data.

137. (Previously Presented) The machine readable medium of claim 132, wherein
displaying the advertising comprises:

displaying the advertisement within a cell of a primary navigation option, the cell within the
navigation interface.

138. (Previously Presented) The machine readable medium of claim 132, having
further instructions stored therein, which when executed cause the machine to perform further
operations, comprising:

displaying the content simultaneous with the advertisement.

139. (Previously Presented) The machine readable medium of claim 132, having
further instructions stored therein, which when executed cause the machine to perform further
operations, comprising:

receiving one bid of the plurality of bids from a client through a web based interface.

140. (Previously Presented) The machine readable medium of claim 132, wherein
displaying the advertisement is through a user terminal which is any one of an interactive television
system, web appliance, computer system or wireless device.

141. (Previously Presented) The machine readable medium of claim 132, wherein the navigation interface includes a plurality of cells corresponding to primary navigation options.

142. (Previously Presented) The machine readable medium of claim 132, having further instructions stored therein, which when executed cause the machine to perform further operations, comprising:

receiving a selection of a unique navigation option from a remote control or a pointer device.

143. (Previously Presented) The machine readable medium of claim 132, having further instructions stored therein, which when executed cause the machine to perform further operations, comprising:

displaying a web based interface for receiving the plurality of bids.

144. (Previously Presented) The machine readable medium of claim 143, wherein the web based interface includes client options for modifying a bid.

145. (Previously Presented) The machine readable medium of claim 132, having further instructions stored therein, which when executed cause the machine to perform further operations, comprising:

tracking user selection of a navigation option; and

displaying a report of aggregated user selections.

146. (Previously Presented) The machine readable medium of claim 132, having further instructions stored therein, which when executed cause the machine to perform further operations, comprising:

reformatting content from a website to display through the navigation interface with the advertisement.

147. (Previously Presented) The machine readable medium of claim 132, having further instructions stored therein, which when executed cause the machine to perform further operations, comprising:

ranking bids to display advertisements in a layer at a maximum depth of the navigation interface.

148. (Previously Presented) The machine readable medium of claim 132, having further instructions stored therein, which when executed cause the machine to perform further operations, comprising:

ranking bids to display advertisements in a specific layer of the navigation interface.

149. (Previously Presented) The machine readable medium of claim 132, wherein displaying the advertising comprises:

displaying the advertisement in a primary navigation option within the navigation interface, the primary navigation option not in a cell or matrix.

150. (Previously Presented) The machine readable medium of claim 132, having further

instructions stored therein, which when executed cause the machine to perform further operations, comprising:

displaying the navigation interface as an overlay over the advertisement.

151. (Previously Presented) The machine readable medium of claim 132, having further instructions stored therein, which when executed cause the machine to perform further operations, comprising:

displaying the content simultaneous with the advertisement, the content including any one of audio content or video content.

152. (Previously Presented) The machine readable medium of claim 132, having further instructions stored therein, which when executed cause the machine to perform further operations, comprising:

receiving navigation input selections from a voice recognition system.

153. (Previously Presented) The machine readable medium of claim 132, having further instructions stored therein, which when executed cause the machine to perform further operations, comprising:

receiving bids, advertisements and content over the internet from a remote machine.

154. (Previously Presented) The machine readable medium of claim 132, wherein each of the plurality of bids corresponds to a fixed time slot.

155. (Previously Presented) The machine readable medium of claim 132, having further instructions stored therein, which when executed cause the machine to perform further operations, comprising:

tracking user navigation for a pay-for-performance system.

156. (Previously Presented) A method comprising:

receiving a plurality of bids to display advertising in association with a keyword;

ranking the plurality of bids based on at least one criterion; and

displaying an advertisement associated with a highest ranked bid of the plurality of bids with the keyword in a navigation interface, the navigation interface having a plurality of increasingly specific hierarchical layers.

157. (Previously Presented) The method of claim 156, further comprising:

providing an account management interface to a user through the navigation interface.

158. (Previously Presented) The method of claim 156, further comprising:

providing an auction or reverse auction through the navigation interface.

159. (Previously Presented) The method of claim 156, wherein the keyword is a category.

160. (Previously Presented) The method of claim 156, further comprising:

retaining user data for each of a plurality of users of the navigation interface; and

customizing the display of the navigation interface based on the user data.

161. (Previously Presented) The method of claim 156, wherein displaying the advertising comprises:

displaying the advertisement within a cell of a primary navigation option, the cell within the navigation interface.

162. (Previously Presented) The method of claim 156, further comprising:
displaying content with the advertisement.

163. (Previously Presented) The method of claim 156, further comprising:
obtaining one bid of the plurality of bids from a client through a web based interface.

164. (Previously Presented) The method of claim 156, wherein displaying the advertisement is through a user terminal which is any one of an interactive television system, web appliance, computer system or wireless device.

165. (Previously Presented) The method of claim 156, wherein the navigation interface includes a plurality of cells corresponding to primary navigation options.

166. (Previously Presented) The method of claim 156, further comprising:
receiving a selection of a navigation option from a remote control or pointer device.

167. (Previously Presented) The method of claim 156, further comprising:

displaying a web based interface for receiving the plurality of bids.

168. (Previously Presented) The method of claim 167, wherein the web based interface includes client options for modifying a bid.

169. (Previously Presented) The method of claim 156, further comprising:
tracking user selection of a navigation option; and
displaying a report of aggregated user selections.

170. (Previously Presented) The method of claim 156, further comprising:
reformatting content from a website to display through the navigation interface with the advertisement.

171. (Previously Presented) The method of claim 156, further comprising:
receiving a unique input to select a primary navigation option corresponding to the advertisement.

172. (Previously Presented) The method of claim 156, further comprising:
ranking bids to display advertisements in a layer at a maximum depth of the navigation interface.

173. (Previously Presented) The method of claim 156, further comprising:
ranking bids to display advertisements in a specific layer of the navigation interface.

174. (Previously Presented) The method of claim 156, wherein displaying the advertising comprises:

displaying the advertisement in a primary navigation option within the navigation interface, the primary navigation option not in a cell or matrix.

175. (Previously Presented) The method of claim 156, further comprising:

displaying the navigation interface as an overlay over the advertisement.

176. (Previously Presented) The method of claim 156, further comprising:

displaying content simultaneous with the advertisement, the content including any one of audio content or video content.

177. (Previously Presented) The method of claim 156, further comprising:

receiving navigation input selections from a voice recognition system.

178. (Previously Presented) The method of claim 156, further comprising:

receiving bids, advertisements and content over an internet from a remote machine.

179. (Previously Presented) The method of claim 156, wherein each of the plurality of bids corresponds to a fixed time slot.

180. (Previously Presented) The method of claim 156, further comprising:

tracking user navigation for a pay-for-performance system.

181. (Previously Presented) A machine readable medium having instruction stored therein, which when executed cause a machine to perform a set of operations comprising:

receiving a plurality of bids to display advertising in association with a category or keyword;

ranking the plurality of bids based on at least one criterion; and

displaying an advertisement associated with a highest ranked bid of the plurality of bids with the category or keyword in a navigation interface, the navigation interface having a plurality of increasingly specific hierarchical layers.

182. (Previously Presented) The machine readable medium of claim 181, having further instructions stored therein, which when executed cause the machine to perform further operations, comprising:

providing an account management interface to a user through the navigation interface.

183. (Previously Presented) The machine readable medium of claim 181, having further instructions stored therein, which when executed cause the machine to perform further operations, comprising:

providing an auction or reverse auction through the navigation interface.

184. (Previously Presented) The machine readable medium of claim 181, wherein the keyword is a category.

185. (Previously Presented) The machine readable medium of claim 181, having further instructions stored therein which when executed cause the machine to perform a further set of operations comprising:

retaining user data for each of a plurality of users of the navigation interface; and
customizing the display of the navigation interface based on the user data.

186. (Previously Presented) The machine readable medium of claim 181, wherein displaying the advertising comprises:

displaying the advertisement within a cell of a primary navigation option, the cell within the navigation interface.

187. (Previously Presented) The machine readable medium of claim 181, having further instructions stored therein which when executed cause the machine to perform a further set of operations comprising:

displaying content with the advertisement.

188. (Previously Presented) The machine readable medium of claim 181, having further instructions stored therein which when executed cause the machine to perform a further set of operations comprising:

obtaining one bid of the plurality of bids from a client through a web based interface.

189. (Previously Presented) The machine readable medium of claim 181, wherein displaying the advertisement is through a user terminal which is any one of an interactive television system, web appliance, computer system or wireless device.

190. (Previously Presented) The machine readable medium of claim 181, wherein the navigation interface includes a plurality of cells corresponding to primary navigation options.

191. (Previously Presented) The machine readable medium of claim 181, having further instructions stored therein which when executed cause the machine to perform a further set of operations comprising:

receiving a selection of a navigation option from a remote control.

192. (Previously Presented) The machine readable medium of claim 181, having further instructions stored therein which when executed cause the machine to perform a further set of operations comprising:

displaying a web based interface for receiving the plurality of bids.

193. (Previously Presented) The machine readable medium of claim 192, wherein the web based interface includes client options for modifying a bid.

194. (Previously Presented) The machine readable medium of claim 181, having further instructions stored therein which when executed cause the machine to perform a further set of operations comprising:

tracking user selection of a navigation option; and
displaying a report of aggregated user selections.

195. (Previously Presented) The machine readable medium of claim 181, having further instructions stored therein which when executed cause the machine to perform a further set of operations comprising:

reformatting content from a website to display through the navigation interface with the advertisement.

196. (Previously Presented) The machine readable medium of claim 181, having further instructions stored therein which when executed cause the machine to perform a further set of operations comprising:

receiving a unique input to select a primary navigation option corresponding to the advertisement.

197. (Previously Presented) The machine readable medium of claim 181, having further instructions stored therein which when executed cause the machine to perform a further set of operations comprising:

ranking bids to display advertisements in a layer at a maximum depth of the navigation interface.

198. (Previously Presented) The machine readable medium of claim 181, having further instructions stored therein which when executed cause the machine to perform a further set of operations comprising:

ranking bids to display advertisements in a specific layer of the navigation interface.

199. (Previously Presented) The machine readable medium of claim 181, having further instructions stored therein which when executed cause the machine to perform a further set of operations comprising:

displaying the advertisement in a primary navigation option within the navigation interface, the primary navigation option not in a cell or matrix.

200. (Previously Presented) The machine readable medium of claim 181, having further instructions stored therein which when executed cause the machine to perform a further set of operations comprising:

displaying the navigation interface as an overlay over the advertisement.

201. (Previously Presented) The machine readable medium of claim 181, having further instructions stored therein which when executed cause the machine to perform a further set of operations comprising:

displaying content simultaneous with the advertisement, the content including any one of audio content or video content.

202. (Previously Presented) The machine readable medium of claim 181, having further

instructions stored therein which when executed cause the machine to perform a further set of operations comprising:

receiving navigation input selections a voice recognition system.

203. (Previously Presented) The machine readable medium of claim 181, having further instructions stored therein which when executed cause the machine to perform a further set of operations comprising:

receiving bids, advertisements and content over an internet from a remote machine.

204. (Previously Presented) The machine readable medium of claim 181, wherein each of the plurality of bids corresponds to a fixed time slot.

205. (Previously Presented) The machine readable medium of claim 181, having further instructions stored therein which when executed cause the machine to perform a further set of operations comprising:

tracking user navigation for a pay-for-performance system.

IX. EVIDENCE APPENDIX

Not Applicable.

X. RELATED PROCEEDINGS APPENDIX

There are no other appeals or interferences that will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.